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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
09 815,978	03 22 2001	David A. Schwartz	37154-0753	7639

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SAN DIEGO, CA 92121

EXAMINER

RUSSEL, JEFFREY E

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 08/26/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,978

Applicant(s)

SCHWARTZ, DAVID A.

Examiner

Jeffrey E. Russel

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-53 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-4, 22-31, 34, and 40-44, drawn to compounds and their methods of use, classified in class 548, subclass 536.
 - II. Claims 5-7, 32, 35, 38, 49, and 52, drawn to compounds and their methods of use, classified in class 560, subclass 169.
 - III. Claims 8, 9, 33, 36, 37, 39, 45, and 50, drawn to compounds and their methods of use, classified in class 564, subclass 123.
 - IV. Claims 10-13, 46, 51, and 53, drawn to compounds and their methods of use, classified in class 546, subclass 298.
 - V. Claims 14-16, drawn to compounds and their methods of use, classified in class 546, subclass 306.
 - VI. Claims 17 and 18, drawn to compounds and their methods of use, classified in class 564, subclass 256.
 - VII. Claims 19, 20, and 47, drawn to compounds and their methods of use, classified in class 546, subclass 306.
 - VIII. Claims 21 and 48, drawn to compounds and their methods of use, classified in class 564, subclass 256.

The inventions are distinct, each from the other, because the compounds recited in each group of claims have structures which are materially different from the compounds recited in the other groups. Each group of claims will require separate structure searches which are not required for the other groups, and the number of separate structure searches which would be

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required in order to search all of the instant claims would constitute an undue burden on the examiner.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

2. If Applicants elect the invention of Group I, then Applicants are required to make the following election of species:

This application contains claims directed to the following patentably distinct species of the claimed invention: The compounds recited in claims 3 and 4 are patentably distinct from each other because of their materially different structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-2, 22, 25-30, and 40-44 are generic.

3. If Applicants elect the invention of Group IV, then Applicants are required to make the following election of species:

This application contains claims directed to the following patentably distinct species of the claimed invention: The compounds recited in claim 13 are patentably distinct from each other because of their materially different structures.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 10-13, 46, 51, and 53 are generic.

4. If Applicants elect the invention of Group V, then Applicants are required to make the following election of species:

This application contains claims directed to the following patentably distinct species of the claimed invention: The compounds recited at claim 14, page 66, line 5 and line 10, are patentably distinct from each other because of their materially different structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 14-15 are generic.

5. If Applicants elect the invention of Group VI, then Applicants are required to make the following election of species:

This application contains claims directed to the following patentably distinct species of the claimed invention: The compounds recited at claim 17, line 2 and line 4, are patentably distinct from each other because of their materially different structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17-18 are generic.

6. If Applicants elect the invention of Group VII, then Applicants are required to make the following election of species:

This application contains claims directed to the following patentably distinct species of the claimed invention: The compounds recited at claim 19, lines 2, 3, 4, and 5, are patentably distinct from each other because of their materially different structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 19 and 47 are generic.

7. If Applicants elect the invention of Group VIII, then Applicants are required to make the following election of species:

This application contains claims directed to the following patentably distinct species of the claimed invention: The compounds recited at claim 21, lines 2, 3, 4, and 5, are patentably distinct from each other because of their materially different structures.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 21 and 48 are generic.

8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after

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the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

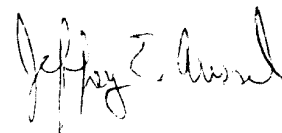
Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. The Sequence Listing filed March 22, 2001 has been approved.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey E. Russel at telephone number (703) 308-3975. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Christopher Low can be reached at (703) 308-2923. The fax number for Art Unit 1653 for formal communications is (703) 305-3014; for informal communications such as proposed amendments, the fax number (703) 746-5175 can be used. The telephone number for the Technology Center 1 receptionist is (703) 308-0196.



Jeffrey E. Russel
Primary Patent Examiner
Art Unit 1653

JRussel
August 14, 2002